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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/505,463	04/08/2005	Christoph Fankhauser	27392/26387	1758
4743 7590 06/26/2008 MARSHALL, GERSTEIN & BORUN LLP 233 S. WACKER DRIVE, SUITE 6300 SEARS TOWER CHICAGO, IL 60606			EXAMINER WOODALL, NICHOLAS W	
			ART UNIT 3733	PAPER NUMBER
			MAIL DATE 06/26/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/505,463

**Applicant(s)**

FANKHAUSER ET AL.

**Examiner**

Nicholas Woodall

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3,5-10,12-16 and 18-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,5-10,12-16 and 21 is/are rejected.
- 7) ☒ Claim(s) 18-20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 January 2008 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This action is in response to applicant's amendment received on 01/16/2008.

#### ***Allowable Subject Matter***

2. The indicated allowability of claim 17 is withdrawn in view of the newly discovered reference(s) to Takase (U.S. Patent 5,221,036). Rejections based on the newly cited reference(s) follow.

#### ***Drawings***

3. The drawings were received on 01/16/2008. These drawings are not acceptable for the following reasons.
4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the pins having a concave end face (Claim 13) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. The applicant has pointed to amended figure 1 to show this limitation. However, the examiner is unable to distinguish the end face of the pins (15) having a concave face.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate

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changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 5, 6, 8-10, 12-16, and 18 rejected under 35 U.S.C. 103(a) as being unpatentable over Takase (U.S. Patent 5,221,036) in view of Alvarado (U.S. Patent 4,583,670).

Takase discloses a device comprising a medial forceps handle, a lateral forceps handle, a medial forceps limb, a lateral forceps limb, a magazine comprising at least two marking bodies attached to a magazine retainer on one the lateral forceps limb, and pins extending from the medial forceps limb towards the lateral forceps limb (see Figure 1 below). The magazine is manufactured from a material capable of being sterilized and further comprises boreholes containing the marking bodies, wherein the boreholes are arranged in several rows to span a plane. Takase does not explicitly disclose the device

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being sterilized, but the examiner believes it is well known in the art that all surgical tools and implants, such as staples, are sterilized prior to use in order to prevent the surgical area from becoming infected. The marking bodies, i.e. the staples, are elongated and define conical tips (see Figures 10-12 of the reference) and are made from metal and produce a contrast relative to bone in a radiographic image, i.e. an x-ray. The pins are arranged in mutual alignment with the boreholes of the magazine such that the marking bodies are pressed out of the magazine at the same time. Takase fails to disclose the device further comprising a guide attached to the distal end of the lateral forceps limb, the marker bodies being cylindrical, the conical tip having an angle between 30 and 60 degrees, and the pins having a concave end face. Alvarado teaches a device comprising a lateral limb further comprising a guide (52) attached to the distal end of the lateral limb in order to guide the device along an incision. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of Takase wherein the lateral limb further comprises a guide in view of Alvarado in order to guide the device along an incision. Regarding the marker bodies being cylindrical and the end face of the pins being concave, it would have been an obvious matter of design choice to one skilled in the art at the time the invention was made to provide the marker bodies having a cylindrical shape and the end face of the pins being concave, since applicant has not disclosed that such solve any stated problem or is anything more than one of numerous shapes or configurations a person of ordinary skill in the art would find obvious for the purpose of providing marker bodies and the end face of pins. In re Dailey and Eilers, 149 USPQ 47 (1966). The examiner is

interpreting the outer surface of the cylindrical shape to be spherical. Regarding the conical tip of the marker bodies having an angle between 30 and 60 degrees, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the conical tip of the marker bodies having an angle between 30 and 60 degrees, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

7. Claims 3 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takase (U.S. Patent 5,221,036) in view of Alvarado (U.S. Patent 4,583,670) further in view of Bauer (U.S. Patent 5,351,871).

The device of Takase as modified by Alvarado discloses the invention as claimed except for the device further comprising a spring including two plate springs arranged on the forceps handles. Bauer teaches a device further comprising two complementary plate springs arranged on forceps handles in order to allow the forceps handles to be resilient. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of Takase as modified by Alvarado further comprising a spring in view of Bauer in order to allow the handles to be resilient.

***Allowable Subject Matter***

8. Claims 18-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

9. The applicant did not provide any arguments directed to the claims. The examiner has withdrawn previously indicated allowability of claim 17 and has presented new grounds of rejection not necessitated by the amendment making this office action non-final.

***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 for cited references the examiner felt were relevant to the application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Woodall whose telephone number is (571)272-5204. The examiner can normally be reached on Monday to Friday 8:00 to 5:30 EST..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nicholas Woodall/

Examiner, Art Unit 3733

/Eduardo C. Robert/

Supervisory Patent Examiner, Art Unit 3733